

## REMARKS

### **Summary of Office Action**

In the Office Action mailed February 12, 2007, the Examiner rejected claim 22 under 35 U.S.C. §112, first paragraph. The Examiner next rejected claims 2 and 20 under 35 U.S.C. §112, second paragraph. Claims 1-11, 14, 20, 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kress* (USP 6,692,198) in view of *Kress et al.* (USP 4,344,724). The Examiner also rejected claims 12, 13, 15-19, and 21 under 35 U.S.C. §103(a) as being unpatentable over *Kress* '198 in view of *Kress* '724 and further in view of *Schulz et al.* (USP 5,549,975).

### **Arguments Supporting Patentability**

The Examiner rejected claim 22 asserting that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 22 depends from claim 1 and further defines the “screw part” as being held in compression relative to the adjusting element to allow translation of the cutting insert upon translation of the adjusting element. Referring to Figs. 2 to 7, page 9, paragraph 2 of the specification discloses that the threaded section 58 of the screw part goes over a step 60 into a head 62 having a wedge-shaped beveling. The specification further states that the beveled wedge surface 64 of head 62 is oriented toward center axis 66 in such a way that when adjusting screw arrangement 52, 56 is in place and is placed under pressure, the surface can be brought to be seated flatly on a flank 68 of cutting insert 16. Figures 3, 4, 5 and 9 clearly show this configuration. Likewise, claim 22 clearly recites that which is disclosed in the application as filed. Accordingly, Applicant respectfully requests that the rejection of claim 22 under 35 U.S.C. §112, first paragraph be withdrawn as being misplaced.

With respect to the rejection of claim 2 under 35 U.S.C. §112, second paragraph, Applicant has amended claim 2 to correct the inadvertent antecedent basis issue with respect to the “constriction” limitation. Applicant respectfully requests that the amendment to claim 2 be

entered as placing the claims in better condition for appeal.

The Examiner also rejected claim 20 under 35 U.S.C. §112, second paragraph asserting that “from the way [‘... the cutting insert is formed by a DIN/ISO indexable insert’] is written, it is not clear how the ‘DIN/ISO’ limits the claimed subject matter.” One of ordinary skill in the art would readily appreciate that the ‘DIN/ISO’ terminology, as indicated in the Specification and stated in the previous response, is a term of art that is commonly used to define specific types, or standardized, cutting inserts. Specifying that the insert is a DIN/ISO insert and that the insert is indexable both further define the claimed invention. Accordingly, Applicant respectfully requests that the rejection of claim 20 under 35 U.S.C. §112, second paragraph also be withdrawn as being misplaced.

The Examiner next rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over *Kress '198* in view of *Kress et al. '724*. Applicant respectfully disagrees.

As the Examiner is aware, the burden of establishing a prima facie case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Accordingly, to establish a prima facie obviousness rejection, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner's burden to establish a prima facie case of obviousness requires three basic criteria be met. That is, the reference(s) must (1) teach or suggest each and every element called for in the claims, must (2) include a motivation or suggestion to combine or modify the reference(s), and must (3) contain a reasonable likelihood of success in yielding the claimed invention from the alleged combination and/or modification of the reference(s). In the case at hand, the Examiner has failed to establish any of the criteria. That is, the references alone or in combination do not disclose, teach, or suggest each and every limitation of the presently claimed

invention. The Examiner's rejection of the claims, although lengthy, also fails to address each and every limitation of the claims. As the references of record do not disclose each and every limitation of claims with as much specificity as called for in the claims, the claims cannot be rendered obvious in view of these same references.

MPEP §2143.01 further requires that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP § 2143.01. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. Not only does the art of record fail to teach or suggest each and every limitation called for in the claims, the references also fail to suggest or motivate the combination alleged by the Examiner.

Claim 1 calls for, in part, an adjusting screw arrangement that comprises a threaded sleeve that is held with play in a smooth through opening having a constriction and which comprises a screw part standing in functional engagement therewith such that the screw part operationally engages with the adjusting element for securing a position of the adjusting element relative to the cutting insert. There is no comparable structure disclosed in the art of record and the Examiner's rejection simply disregards those elements of the claimed invention which are lacking in the art of record. Specifically, claim 1 defines a cutting tool having an opening with “a constriction” in which a screw part stands in functional engagement with a sleeve. Claim 1 further defines that the screw part is operationally engaged with the adjusting element for securing a position of the adjusting element relative to the cutting insert. That is, claim 1 includes a threaded sleeve that is held in a smooth through opening that includes a constriction. The art of record, and even the Examiners strained interpretation thereof, fails to teach and/or suggest such a cutting tool having the construction defined by claim 1.

Even assuming arguendo that one of ordinary skill in the art would consider either of members 4 or 5 as “threaded sleeves”, such sleeve (5) would not be held in play in a smooth through opening having a constriction. As shown in the drawings, and particularly Fig. 1, screw arrangement 4, 6, 5 is positioned in a through opening and is positioned in the center by the two oblique surfaces 41, 51. That is, it is not a constriction of the opening that secures the position of the screw arrangement but the engagement of the beveled faces of the holder with a beveled surface of the cutting insert. The art of record simply fails to disclose, teach, or suggest that which is defined by the present claims.

An obviousness-type analysis further requires that the Examiner examine the rejected claims as a whole and without the advantages of hindsight to determine if the rejected claims are obvious in light of the cited references. As a result, a rejection of a claim under 35 U.S.C. §103(a) is improper if the claimed invention is employed as an instruction manual to modify the teachings of the prior art references so that the claimed invention is rendered obvious. The disclosure of a reference must be considered in its entirety rather than simply considering bits and pieces thereof. Simply, “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (In Re Fritch, 972 F.2d 1260, 23 USPQ. 2d 1780, 1784 (Fed. Cir. 1992) citing In Re Fine, 837 F.2d 1071, 1075, 5 USPQ. 2d 1596, 1600 (Fed. Cir. 1988)).

The Examiner seems to have mischaracterized the insert holder of *Kress* ‘724 in a self-serving attempt to support an improper rejection. As best shown in Figs. 1 and 6 of *Kress* ‘724, the holder of *Kress* ‘724 includes a pair of support members 4, 5 that are constructed to engage opposite sides of a knife plate 3 such that translation of the support members 4, 5, relative to the rearward faces 34, 35 of plate 3 allows translation of the knife plate 3. The impermissible hindsight is apparent in the strained attempt to construct the claimed cutting tool with the limitations described in detail previously from a combination of references that each only disclose isolated elements of the claimed invention.

Furthermore, as also supported above, even assuming arguendo that the references were

combinable, even the combination of references fails to disclose, teach, or suggest each and every limitation of the pending claims. Alone or in combination, the references of record fail to disclose, teach, or suggest each and every element as called for in the present claims. The combination of references is also devoid of the requisite suggestion or motivation to combine the references in the manner done by the Examiner in attempting to achieve the claimed invention. One of ordinary skill in the art would readily appreciate that the adjusters of *Kress* '724 are threaded screws that are held in threaded sleeves which are held in threaded passages of the holder. Only the present application discloses or suggests a screw arrangement that includes a screw that cooperates with a sleeve which is received in a smooth through opening having a constriction such that the sleeve is insertable from a first side and is operable from a second side generally opposite insertion side.

Accordingly, Applicant believes that which is called for in claim 1, and the claims that depend therefrom are patentably distinct over the art of record.

With respect to the Examiner's rejection of claims 2-22 under 35 U.S.C. §103(a) as being unpatentable over various combinations of the art of record, as these rejections rely partly upon the Examiner's misplaced interpretation of the art, Applicant believes these claims are also patentably distinct over the art of record at least for the reasons set forth above in addition to depending from a claim that is believed to be otherwise allowable.

Therefore, in light of the forgoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests an indication of the same for claims 1-22.

Applicant hereby respectfully requests a one-month (1) extension of time in which to respond to the extension. Applicant authorizes a Charge to Deposit Account No. 50-1170 for the corresponding fee (\$120.00). The Director is hereby authorized to charge any other required fees associated with this or any other communication, or credit any overpayment, to Deposit Account No. 50-1170. Applicant appreciates the Examiner's consideration of these amendments and remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved which would hinder the passage of the above-captioned matter to issuance.

Respectfully submitted,  
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